



Paper No. 10

Walter Joseph Mikulski
AMCONGEN/RIMC
PSC 115
APO AE 09213-0115
Germany

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JAN 15 2003

In re Application of
Walter Joseph Mikulski
Application No. 09/490,859
Filed: January 24, 2000
Attorney Docket No. 1.827.99

**OFFICE OF PETITIONS
ON PETITION**

This is a decision on the petition under 37 CFR 1.137(a), filed September 9, 2002, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration or petition under 37 CFR 1.137(b) must be submitted within TWO (2) MONTHS from the mail date of this decision. Extension of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C § 704.

The above-identified application became abandoned for failure to respond to the non-final Office action mailed October 2, 2001, which set a shortened statutory period for reply of three months from its mailing date. No response was received within the allowable period, and the application became abandoned on January 3, 2002. A Notice of Abandonment was mailed on April 10, 2002.

A grantable petition under 37 CFR 1.137(a)¹ must be accompanied by: (1) the required reply,² unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer required by 37 CFR 1.137(c).

The instant petition lacks items (1) and (3).

With regard to item (1), petitioner is advised that a proper response to the non-final Office action must be filed before the application can be revived. A proper response would be either an amendment or a continuing application.

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the

¹As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

² In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.137(a).

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner's interpretation of those provisions is entitled to considerable deference."³

"[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked **any** basis in reason or common sense."⁴

"The court's review of a Commissioner's decision is 'limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.'"⁵

"The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgement for that of the agency."⁶

The standard

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."⁷

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"⁸ Nonawareness of a PTO rule will not

³Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute."))

⁴Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

⁵Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. §706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

⁶Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

⁷Id.

⁸See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

constitute unavoidable delay.⁹

Application of the standard to the current facts and circumstances

In the instant petition, petitioner maintains that the circumstances leading to the abandonment of the application meet the aforementioned unavoidable standard and, therefore, petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner asserts that petitioner did not file a timely response to the non-final Office action because: (a) petitioner was having problems with petitioner's attorney, (b) petitioner did not know whether petitioner could deal directly with the USPTO, and (c) petitioner is overseas and had trouble dealing with the USPTO.

With regard to item (3) above, the aforementioned arguments of petitioner in support of petitioner's belief that the above-cited application was unavoidably abandoned are not persuasive. The reasons petitioner's arguments must necessarily fail are addressed below.

The word 'unavoidable' as it is used in 37 CFR 1.137(a) is a term of art which means that despite doing all that was reasonable and prudent for petitioner to do, the application still went abandoned. Although it is appreciated that petitioner is pro se, under the unavoidable standard petitioner is still expected to treat the prosecution of the patent application as his most important business, and there are few circumstances that would mitigate petitioner's failure to file a timely and proper response to an Office action. While it is recommended that pro se applicants retain a patent agent to assist with the prosecution of patent application, it is not mandatory, therefore; a dispute between petitioner and the attorney retained will not be sufficient to establish unavoidable delay. Petitioner, as the inventor of the invention, is still empowered to take action in his patent application, with or without the attorney or patent agent. Hence, petitioner's failure to provide a timely response to the Office action because of a dispute with the attorney retained does not amount to unavoidable delay.

Relative to the petitioner's assertion that petitioner did not know whether petitioner could deal directly with the USPTO, petitioner is advised that section 711.03(c) of the Manual of Patent Examining Procedure (MPEP) provides that "[d]elay resulting from the lack of knowledge or improper application of the patent statute, rules, of practice, or the MPEP . . ." does not constitute unavoidable delay. Any assertion by petitioner that because petitioner was unaware of the practices of the USPTO the response to the Office action was unavoidably delayed must fail. Again, as the sole named inventor on the instant application, petitioner is always in a position to prosecute the application directly.

Relative to petitioner's assertion that the fact that petitioner is overseas in a job that requires extensive travel contributed to the petitioner's unavoidable delay in responding to the non-final Office action, petitioner is advised that the prosecution of a patent application requires the applicant to make such prosecution applicant's most important business. While it is appreciated

⁹See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

that petitioner may be experiencing some extraordinary circumstances, petitioner's hectic work assignment and schedule will not suffice to qualify any delay in responding to the non-final Office action as unavoidable. Such delay may be unintentional, however, and a petition under 37 CFR

1.137(b) remains an option to petitioner. Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply (already submitted), the required petition fee (\$1,280.00 for a large entity and \$640.00 for a verified small entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. A copy of a blank petition form PTO/SB/64 is enclosed for petitioner's convenience.

It is noted that petitioner remitted \$640.00 towards payment of the issue fee for the application. It does not appear, however, that a "Notice of Allowance and Issue Fee Due" was yet issued for the subject application. The amount of \$640.00 is, therefore, refunded to petitioner in due course.

Further, it is noted that petitioner requested an extension of time in which to respond to the non-final Office action. The request for an extension of time was made outside the maximum statutory period set for reply and cannot be granted.

The "Change of Correspondence Address" form, filed September 9, 2002, is noted and made of record.

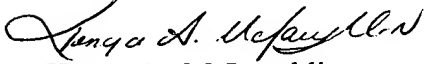
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, DC 20231

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clarke Place
Crystal Plaza 4, Suite 3C23
Arlington, Virginia 22202

Telephone inquiries regarding this decision should be directed to the undersigned (703) 305-0010.


Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure: PTO/SB/64

UNITED STATES PATENT & TRADEMARK OFFICE
Washington, D.C. 20231

REQUEST FOR PATENT FEE REFUND										
1 Date of Request: <u>1/23/03</u>		2 Serial/Patent # <u>09/490,859</u>								
3 Please refund the following fee(s):		4 PAPER NUMBER	5 DATE FILED	6 AMOUNT						
	Filing			\$						
	Amendment			\$						
	Extension of Time			\$						
	Notice of Appeal/Appeal			\$						
<input checked="" type="checkbox"/>	Petition	9	9/9/02	\$ 640.00						
	Issue			\$						
	Cert of Correction/Terminal Disc.			\$						
	Maintenance			\$						
	Assignment			\$						
	Other			\$						
7 TOTAL AMOUNT OF REFUND			\$ 640.00							
8 TO BE REFUNDED BY:										
10 REASON:		<input checked="" type="checkbox"/> Treasury Check								
	Overpayment	Credit Deposit A/C #:								
	Duplicate Payment	9 <table border="1" style="display: inline-table; border-collapse: collapse;"><tr><td style="width: 20px; height: 20px;"></td><td style="width: 20px; height: 20px;"></td><td style="width: 20px; height: 20px; text-align: center;">--</td><td style="width: 20px; height: 20px;"></td><td style="width: 20px; height: 20px;"></td><td style="width: 20px; height: 20px;"></td></tr></table>					--			
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<input checked="" type="checkbox"/>	No Fee Due (Explanation):									
Petition treated as pt under 1.137(a)										
11 REFUND REQUESTED BY:										
TYPED/PRINTED NAME: <u>Henry A. McLaughlin</u>		TITLE: <u>Petitions Atty.</u>								
SIGNATURE: <u>Henry A. McLaughlin</u>		PHONE: <u>205-0010</u>								
OFFICE: <u>Petitions Att Office</u>										
***** THIS SPACE RESERVED FOR FINANCE USE ONLY: *****										
APPROVED: <u>Alicia Kelly</u>		DATE: <u>1/22/03</u>								

Instructions for completion of this form appear on the back. After completion, attach white and yellow copies to the official file and mail or hand-carry to:

**Office of Finance
Refund Branch
Crystal Park One, Room 802B**